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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/774,470	01/30/2001	Eric D. Peterson	22965-3580	5284

25213 7590 08/01/2003

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EXAMINER

STAICOVICI, STEFAN

ART UNIT	PAPER NUMBER
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1732

DATE MAILED: 08/01/2003.

12

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/774,470

Applicant(s)

PETERSON, ERIC D.

Examiner

Stefan Staicovici

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 17 July 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires four months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See attachment.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: None.

Claim(s) objected to: None.

Claim(s) rejected: 1-3,5,7,16 and 19-21.

Claim(s) withdrawn from consideration: _____.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☒ Other: See attachment

ATTACHMENT TO ADVISORY ACTION

Response to Amendment

1. Applicant's After-Final amendment filed July 17, 2003 (Paper No. 11) will not be entered because the proposed amendments raise new issues that would require further consideration and a new search and also, the proposed amendments are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal. Specifically, the newly added limitation in claims 1 and 16 of "applying heat *directly* to said collar *as to cause said collar* to shrink and hot press the polymeric member" (emphasis added) introduces subject matter which has not been previously presented and as such would require further consideration and a new search.

Claims 1-3, 5, 7 and 16-21 are pending in the instant application.

Response to Remarks

2. Applicants' arguments filed July 17, 2003 (Paper No. 11) have been considered.

Applicant argues that the primary reference of Graver, Sr. ('668) does not teach or suggest "direct application of heat to the collar so as to cause it to shrink" (see page 5 of the After-Final amendment filed July 17, 2003). However, as shown above, this argument is drawn to a newly presented claim limitation not previously presented and as such would require further consideration and a new search. Further, it should be noted that the newly added limitation of "applying heat *directly* to said collar" is taught by Graver, Sr. ('668) because the metallic member (12) and the polymeric member (20) are in "direct" contact and the use of the

transitional term “comprising”, is inclusive or open-ended and does not exclude additional, unrecited elements or method steps, such as heating the metallic member (12).

Applicant argues that “heat shrinkability is not an inherent property of vinyl compounds” because “special processing is required” (see page 5 of the After-Final amendment filed July 17, 2003). Under MPEP §2112, in “relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” Ex parte Levy, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). In view of the requirements of MPEP §2112, in the Final Action mailed March 12, 2003 (Paper No. 9) the teachings of EP 0 471 238 A2 were used to show that a vinyl material is a heat shrinking material. Further, it should be noted that EP 0 471 238 A2 teaches shrink fit articles such as a tube, sleeve or tape made from elastomers or thermoplastic rubbers having a vinyl component (see Abstract). Furthermore, Garver, Sr. ('875) teaches that elastomeric member (24) can be made from a plasticized vinyl material (see col. 5, lines 31-33). Therefore, it is submitted that it would be recognized by persons of ordinary skill that the inherent characteristic of “shrinkability” in Garver, Sr. ('875) will “necessarily” flow from the fact that the material is a vinyl material which EP 0 471 238 A2 teaches to be a heat shrinking material.

Conclusion

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stefan Staicovici, Ph.D. whose telephone number is (703) 305-

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0396. The examiner can normally be reached on Monday-Friday 8:00 AM to 5:30 PM and alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael P. Colaianni, can be reached at (703) 305-5493. The fax phone number for this Group is (703) 305-7718.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

Stefan Staicovici, PhD



7/31/03

Primary Examiner

AU 1732

July 31, 2003